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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
TRAN, ELLEN C				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/760,456

Applicant(s)

OHARA ET AL.

Examiner

ELLEN TRAN

Art Unit

2434

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-9, 11, 14 and 16-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-9, 11, 14 and 16-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 10/760,456.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Detailed Action

1. This action is responsive to communication filed on: 17 July 2008 with acknowledgement of an original application filed on 21 January 2004, with the benefit of foreign application JP P2003-012765 filed 21 January 2003, and foreign application JP P2003-0383060 filed 12 November 2003.
2. Claims 1-4, 6-9, 11, 14, 16-21 are pending; claims 1, 4, and 11, are independent claims. Claims 1, 4, 6, 9, 11, and 14, have been amended. Claims 16-21 are new. Claims 5, 10, 12, 13, and 15 have been canceled. Amendments to the claims are accepted.
3. The IDS submitted 29 November 2008 and 6 December 2008 have been considered.

Response to Arguments

4. Applicant's arguments filed 17 July 2008 have been fully considered however they are not moot due to new grounds of rejection below. Note the 112 Rejections are removed due to amendment.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. **Claim 1**, is rejected under 35 U.S.C. 102(b) as being anticipated by Rawson, Sr. et al. U.S. Patent No. 5,949,059 (hereinafter '059).

As to independent claim 1, A storage device comprising: a storage medium having a data area configured to write content data thereto and an identifier area configured to write an identifier thereto, the identifier area being read only memory; and a storage medium support frame configured to hold the storage medium and provided with visible information that is printed on the storage medium support frame and corresponds to the identifier being visible from the outside and selected from the group consisting of a character, symbol, pattern, color, and combination of a character, symbol, pattern, and color” is taught in ‘059 col. 2, lines 43-63 and Fig. 1, note the ‘storage device ... to information stored in the storage device’ is interpreted to be equivalent to the ‘storage medium ... to write content data thereto’.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 2, 3, 4, 6-9, 11, and 14,** are rejected under 35 U.S.C. 103(a) as being unpatentable over Rawson, Sr. et al. U.S. Patent No. 5,949,059 (hereinafter ‘059) in view of Dell U.S. Patent No. 6,745,944 (hereinafter ‘944).

As to dependent claim 3, the following is not explicitly taught in ‘059: **“wherein: the identifier is readable by a writing apparatus; and the writing apparatus displays, on a**

display thereof, information selected from the group consisting of a character, symbol, pattern, color, and combination of a character, symbol, pattern, and color, and when the visible information agrees with the displayed information, conducts writing” however ‘944 teaches that the identifier is displayed in col. 2, lines 18-25, note the interface is also a writing apparatus.

It would have been obvious to one of ordinary skill in the art at the time of the invention a tamper evident labeling system with embedded storage device taught in ‘059 to include to show a user what programs application are available on a secure storage medium. One of ordinary skill in the art would have been motivated to perform such a modification to provide a convenient system of what applications are loaded see ‘944 (col. 1, lines 33 et seq.) “However, the applicant of the present invention recognized that one of the problems in a wide-spread adoption of a multi-application smart card by the industry is that there is no easy way for a user to find out what applications reside in the card. The problem is compounded if the user holds two or more multi-application cards. One solution is to permanently print the symbols or logos of the applications on the card at the time of issuance. As can be appreciated, however, this solution is inadequate. Even though different applications may be loaded and removed from the card from time to time, the permanent printing of the logos cannot be changed to accurately reflect the currently loaded applications. Another solution is to use an external reader device that slips over the card to view the card's content. Such a device, however, is too bulky to carry around with the card”.

As to dependent claim 2, “wherein: the storage medium support frame has a substantially rectangular shape and a short side of at least 31.8 mm” is shown in ‘944 col. 1, lines 12-15, note a credit card is a rectangular shape with a short side of at least 31.8mm.

As to independent claim 4, “wherein the storage device comprises a storage medium having a data area configured to write content data thereto and an identifier area configured to write the identifier thereto, the identifier being read only memory; and a storage medium support frame configured to hold the storage medium and provided with the visible information that is printed on the storage medium support frame and corresponds to the identifier, the visible information being visible from the outside and selected from the group consisting of a character, symbol, pattern, color and combination of a character, symbol, patter, and color” is taught in ‘059 col. 2, lines 43-63 and Fig. 1, note the ‘storage device ... to information stored in the storage device’ is interpreted to be equivalent to the ‘storage medium ... to write content data thereto’; the following is not explicitly taught in ‘059:

“A writing apparatus comprising: a storage unit configured to store an identifier, a software file name, a title of the software, and a visible information file that are related to one another; a display controller configured to read the visible information file and the title from the storage unit and output a display signal to display visible information and the title; a display configured to receive the display signal from the display controller and display the visible information and the title; a slot configured to receive a storage device therein; an identifier reader configured to read an identifier stored in the storage device

inserted in the slot” however ‘944 teaches an identifier related to visible information file in col. 2, lines 36-56;

“an identifier-corresponding-software searcher configured to determine if software corresponding to the identifier read by the identifier reader is stored in the storage unit” however ‘944 teaches the loader application verifies and authenticates if the identified software is on the smartcard in col. 2, line 57 through col. 3, line 9;

“and a writer configured to write the software corresponding to the identifier to the storage device, when the software corresponding to the identifier is present” however ‘944 teaches the interface executes the selected loaded application, part of executing entails writing as interpreted by the Examiner access file, updating memory in smartcard in col. 4, lines 24-56.

As to dependent claim 6, “wherein: the storage medium support frame has a substantially rectangular shape and a short side of at least 31.8 mm” is disclosed in ‘944 col. 1, lines 12-15, note a credit card is a rectangular shape with a short side of at least 31.8mm.

As to dependent claim 7, “wherein: the writer conducts the writing when the visible information on the storage medium agrees with the visible information displayed on the display, the visible information on the display being selected from the group consisting of a character, symbol, pattern, color, and combination of a character, symbol, pattern, and color” is taught in ‘944 col. 2, line 52 through col. 3, line 9.

As to dependent claim 8, “further comprising: a correspondence table rewriter configured to rewrite a correspondence table showing correspondence among the

identifier, file name, title, and visible information file” is shown in ‘944 col. 2, line 52 through col. 3, line 9.

As to dependent claim 9, “further comprising: a communication unit configured to receive data required to rewrite the correspondence table from outside of the writing apparatus” is disclosed in ‘944 col. 3, lines 27-46.

As to independent claim 11, “A computer readable storage medium comprising: an identifier area configured to store a first identifier, the first identifier area being read only memory” is taught in ‘059 col. 2, lines 43-63 and Fig. 1, the following is not explicitly taught in ‘059:

“and a data area configured to store a second identifier content data” however ‘944 teaches that the memory may contain many different types of application and their associated symbols in col. 2, lines 57-67, note the symbols associated with an application are interpreted equivalent to the ‘second identifier’ / the application is equivalent to the ‘content data’;

“and a replay program configured to make a computer execute instructions comprising instructions configured to read the first identifier from the identifier area; instructions configured to read the second identifier from the data area; instructions configured to check whether or not there is a first specific relation between the first identifier and the second identifier; instructions configured to read the content data from the data area; instructions configured to check whether or not there is a second specific relation between the second identifier, the content data and the relay program; and instruction configured to replay the content data when both of the first and second specific conditions are satisfied” however ‘944 teaches as part of loading or removing process that the

loader may verify or authenticate that the appropriate authority to utilize a program in col. 2, line 66 through col. 3, line 9.

It would have been obvious to one of ordinary skill in the art at the time of the invention a tamper evident labeling system with embedded storage device taught in '059 to include to show a user what programs application are available on a secure storage medium. One of ordinary skill in the art would have been motivated to perform such a modification to provide a convenient system of what applications are loaded see '944 (col. 1, lines 33 et seq.) "However, the applicant of the present invention recognized that one of the problems in a wide-spread adoption of a multi-application smart card by the industry is that there is no easy way for a user to find out what applications reside in the card. The problem is compounded if the user holds two or more multi-application cards. One solution is to permanently print the symbols or logos of the applications on the card at the time of issuance. As can be appreciated, however, this solution is inadequate. Even though different applications may be loaded and removed from the card from time to time, the permanent printing of the logos cannot be changed to accurately reflect the currently loaded applications. Another solution is to use an external reader device that slips over the card to view the card's content. Such a device, however, is too bulky to carry around with the card".

As to dependent claim 14, "and a storage medium support frame configured to hold the storage medium and provided with visible information that is printed on the storage medium support frame and corresponds to a part of the identifiers, the visible information being visible from the outside and selected from the group consisting of a character,

symbol, pattern, color, and combination of a character, symbol, pattern, and color” is taught in ‘059 col. 2, lines 43-63 and Fig. 1.

9. **Claims 16-21**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Rawson, Sr. et al. U.S. Patent No. 5,949,059 (hereinafter ‘059) in view of Dell U.S. Patent No. 6,745,944 (hereinafter ‘944) in further view of Venkatesan et al. U.S. Patent No. 6,898,706 (hereinafter ‘706) .

As to dependent claim 16, the following is not explicitly taught in ‘059 and ‘944: **“wherein the first specific relation means that the second identifier is generated by encrypting the first identifier”** however ‘706 teaches encrypting the first identifier in col. 5, lines 21-40.

It would have been obvious to one of ordinary skill in the art at the time of the invention of a system and method for identifying applications loaded in a smart card taught in ‘059 and ‘944 to include a means to make the identification of the application unchangeable. One of ordinary skill in the art would have been motivated to perform such a modification to provide an identifier that would be difficult to remove (i.e. a watermark) see ‘706 (col. 3, lines 66 et seq.) “Therefore, faced with these deficiencies, the art, in the context of digital rights management, appears to be considering the use of watermarking. In essence, a watermark is an identifier that, in the context of a software object, would be tightly integrated into that object but would not be discernible to a third party. Furthermore, that party will likely experience considerably more difficulty in removing a correctly implemented watermark from a software object than removing a digital signature”.

As to dependent claim 17, “wherein the first specific relation means that the second identifier is generated by embedding a watermark in the first identifier” is taught in ‘706 col. 5, lines 21-40, as note multiple watermarks are interpreted to be equivalent to a second watermark, the enforcer watermark specifies the location of the watermark, note the watermark is considered to be unchangeable.

As to dependent claim 18, “wherein the first specific relation means that the second identifier is generated by embedding a watermark in the first identifier and encrypting the same” is shown in ‘706 col. 5, lines 37-59, note the watermark becomes glue between the protected content and its license, if a value of a parameter in the license matches the same parameter in the license the enforcer permits access in accordance with license rights. Note the parameter value matching is interpreted to be equivalent to the ‘predetermined part of the first and second identifiers are identical’.

As to dependent claim 19, “wherein the second specific relation means that both of the second identifier and the content data are encrypted with the use of the replay program” is disclosed in ‘706 col. 5, lines 37-59.

As to dependent claim 20, “wherein the second specific relation means that it is possible for the replay program to read an electronic watermark embedded in the second identifier, to confirm that the second identifier has a correct embedded electronic watermark, to read an electronic watermark embedded in the content data, and to confirm the content data has a correct embedded electronic watermark” is taught in ‘706 col. 5, lines 37-59.

As to dependent claim 21, “the second specific relation means that it is possible for the replay program to decrypt the second identifier, to read an electronic watermark embedded in the decrypted second identifier, to confirm that the second identifier has a correct embedded electronic watermark, to decrypt the content data, to read an electronic watermark embedded in the decrypted content data, and to confirm the content data has a correct embedded electronic watermark” is shown in ‘706 col. 5, lines 37-59.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. It is noted, PATENTS ARE RELEVANT AS PRIOR ART FOR ALL THEY CONTAIN
“The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of

the art, relevant for all they contain.” In re Heck, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting In re Lemelson, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)). A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including nonpreferred embodiments (see MPEP 2123).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen C Tran whose telephone number is (571) 272-3842. The examiner can normally be reached from 7:30 am to 4:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Kambiz Zand can be reached on (571) 272-3811. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/ELLEN TRAN/
Primary Examiner, Art Unit 2434
25 October 2008